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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,821	08/29/2003	Mou-Tang Liou	CFP-1437-2 (15722-309C2P)	2464
23595	7590	02/07/2005	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			MEISLIN, DEBRA S	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/652,821	LIOU, MOU-TANG	
	Examiner	Art Unit	
	Debra S Meislin	3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/3/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 4, 6 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5, 8, 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/03, 12/03, 3/04, 12/04</u> | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election with traverse of Figures 1-5 in the reply filed on January 3, 2005 is acknowledged. Claims 4, 6, and 7 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. It is noted that for a claim to be generic is must be generic to all of the species.
2. Applicant timely traversed the restriction (election) requirement in the reply filed on January 3, 2005.

Applicant contends the following:

Other than the existence of more than one embodiment, the Examiner has not indicated any reason for restriction. From a simple review of issued patents, claims directed to multiple embodiments are often included, and the mere existence of multiple embodiments is not a basis for restriction. In this regard, the Examiner has not indicated that the fields of search are different, that any extra effort would be required for searching or examination, or the like.

Applicant is limited to examination of a single disclosed patentably distinct species for prosecution on the merits. The examiner had indicated that the application contained claims directed to patentably distinct species of the claimed invention. Consequently, a proper traversal would be on the grounds that the species are not patentably distinct. Such a traversal must include evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141.

The fields of search are not required in an election of species. Since more than one species is present, extra effort would be required regarding the examination of all of the claimed species. Applicant's arguments appear to be directed to an election between inventions and not between species.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2, 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of McBride.

Tidwell discloses all of the claimed subject matter except for having a series of recesses in the shank of the bit. McBride discloses a bit having a single recess or a plurality of recesses for receiving a detent. Note figure 2. It would have been obvious to one having ordinary skill in the art to form the bit of Tidwell with a plurality of recesses to allow for the adjustability thereof as taught by McBride.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of McBride as applied above, in further view of White.

White discloses the use of a second locking device (a second ball detent) to assist in securing the tool bit within the cavity of handle. It would have been obvious to

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one having ordinary skill in the art to form the locking device of Tidwell with a second aperture, detent, and notch to assist in securing the tool bit within the cavity of handle as taught by White.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tidwell in view of McBride as applied above, in further view of Her or Lin.

Her or Lin disclose the concept of providing a handle with opposing ends having socket therein for receiving a tool bits. One end of the handle has a socket wrench attached thereto and the other end shows the use of a socket wrench or of a screwdriver bit. It would have been obvious to one having ordinary skill in the art to form one of the tool bits of Tidwell as a screwdriver bit to allow for the engagement and rotation of a screw-type workpiece as taught by Her or Lin.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.



Debra S Meislin
Primary Examiner
Art Unit 3723

February 3, 2005